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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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|---------------------------------|---|-----------------|---------------------------|
| PIONEER KABUSHIKI KAISHA dba |) | Opposition No.: | 125,458 |
| PIONEER CORPORATION, |) | | |
| |) | Mark: | SUPERSCAN ELITE |
| |) | Serial No.: | 76/208230 |
| Opposer, |) | Published: | March 19, 2002 |
| |) | | |
| vs. |) | (1) | OPPOSER'S MOTION FOR |
| |) | | SANCTIONS PURSUANT TO |
| |) | | TRADEMARK RULE OF |
| |) | | PRACTICE 2.120(g) (2) |
| HITACHI HIGH TECHNOLOGIES |) | | AND FEDERAL RULE OF CIVIL |
| AMERICA, INC. formerly known as |) | | PROCEDURE 37, OR |
| NISSEI SANGYO AMERICA, LTD., |) | | ALTERNATIVELY FOR AN |
| |) | | ORDER TO COMPEL THE |
| Applicant. |) | | DEPOSITIONS OF ANTHONY |
| |) | | DUDA, DENNIS BATTAGLIA, |
| |) | | YUJI HIDAKA, MASATSUGU |
| |) | | MISU, and SHIGEHICO |
| |) | | KOBAYASHI; |
| |) | | |
| |) | (2) | MEMORANDUM OF POINTS AND |
| |) | | AUTHORITIES; and |
| |) | | |
| |) | (3) | CERTIFICATE OF ROBERT |
| |) | | JAMES SKOUSEN. |

DISC. CUT-OFF: May 30, 2004

Assistant Commissioner For Trademarks
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07-19-2004

U.S. Patent & TMO/TM Mail Rpt Dt. #22

OPPOSER'S MOTION FOR SANCTIONS PURSUANT TO TRADEMARK RULE OF
PRACTICE 2.120(g)(2) AND FEDERAL RULE OF CIVIL
PROCEDURE 37 OR ALTERNATIVELY TO COMPEL THE DEPOSITIONS
OF ANTHONY DUDA, DENNIS BATTAGLIA, YUJI HIDAKA,
MASATSUGU MISU and SHIGEHICO KOBAYASHI

PLEASE TAKE NOTICE THAT pursuant to Federal Rule of Civil Procedure 37 and Trademark Rules of Practice 2.120(e) and (g), Opposer Pioneer Kabushiki Kaisha dba Pioneer Corporation ("Pioneer") hereby moves the Trademark Trial and Appeal Board ("the Board") for an order of sanctions dismissing the SUPERSCAN ELITE application or other sanctions or, alternatively, for an order compelling Applicant Hitachi High Technologies America, Inc., formerly known as Nissei Sangyo America, Ltd., ("HHTA") to produce ANTHONY DUDA, DENNIS BATTAGLIA, YUJI HIDAKA, MASATSUGU MISU, and SHIGEHICO KOBAYASHI, for their individual depositions pursuant to Rule 30(a)(1) and 37 CFR 2.120(b) in Los Angeles, California at a place and time mutually agreed upon by Pioneer and HHTA.

All of these men were intimately involved in the decisions regarding creation, use, pricing, marketing and distribution of the SUPERSCAN ELITE mark. The refusal to produce these knowledgeable officers and employees of HHTA is yet another example of applicant's ongoing efforts to block Pioneer's rightful discovery efforts. These tactics should neither be countenanced nor approved by the Board.

This motion is based upon this Notice of Motion and Motion, the accompanying Memorandum of Points and

Authorities, the Certificate of Robert James Skousen, all pleadings and papers on file in this action, and upon such other matters as may be presented to the Board.

Dated: July 19, 2004

SKOUSEN & SKOUSEN
A Professional Corporation

By: 

Robert James Skousen
Mark M. Gnesin
Attorneys for Pioneer
Kabushiki Kaisha dba
Pioneer Corporation

MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF MOTION
FOR SANCTIONS OR, ALTERNATIVELY, FOR AN ORDER COMPELLING THE
DEPOSITIONS OF ANTHONY DUDA, DENNIS BATTAGLIA, YUJI HIDAKA,
MASATSUGU MISU, AND SHIGEHICO KOBAYASHI

I.

PRELIMINARY STATEMENT

Opposer Pioneer Kabushiki Kaisha dba Pioneer Corporation ("Pioneer"), brings this motion for sanctions and/or to compel the attendance of ANTHONY DUDA, DENNIS BATTAGLIA, YUJI HIDAKA, MASATSUGU MISU and SHIGEHICO KOBAYASHI ("Deponents") at their individual depositions pursuant to Federal Rules of Civil Procedure 37(d), 30(a)(1), and Trademark Rules of Practice 2.120(b) and (g)(2).

This motion is made necessary due to HHTA's consistent unreasonable refusal to produce ANTHONY DUDA, DENNIS BATTAGLIA, YUJI HIDAKA, MASATSUGU MISU and SHIGEHICO KOBAYASHI ("Deponents") for their individual deposition pursuant to Notice of Depositions for each, all dated April 19, 2004.

HHTA has refused and continues to refuse to provide the Deponents for their Depositions. The stated basis for HHTA's refusal to allow Pioneer to depose the Deponents is set forth by HHTA's counsel, in his letter of April 21, 2004, wherein he conclusorily states: "None of the above named gentlemen would have any pertinent information relating to the adoption or use of the SUPERSCAN ELITE mark that has not already been testified about by Mr. Levans. Whatever

knowledge they have is clearly duplicative of the knowledge of each other and of Mr. Levans."

Federal Rule of Civil procedure 30, the Advisory Committee Notes thereto, and case law specifically contradict HHTA's position and support Pioneer's argument that sanctions, up to and including the dismissal of the HHTA's application, would be appropriate. As an alternative option, this Board should order that Deponents be produced for their individual depositions in Los Angeles, California.

II.

RELEVANT FACTUAL AND PROCEDURAL BACKGROUND

A. Factual Background

Pioneer is the owner of United States Trademark Number 1,591,868 for the mark "ELITE" in International Class 009 for the following goods and services:

[A]udio and video products, namely, amplifiers; video disc players; compact disc players; combination video disc and compact disc players; monitor televisions; loudspeakers; tuners; and stereo radio/audio cassette players.

Pioneer's ELITE mark was registered on the Principal Register on April 17, 1990. Pioneer's registered mark is current, valid and has been continuous to the present time. Pioneer's registered mark is conclusive evidence of Pioneer's exclusive right to use the ELITE mark in commerce on the goods specified in registration number 1,591,868.

On February 9, 2001, HHTA¹ filed its application for the mark SUPERSCAN ELITE in International Class Nine by filing an application for SUPERSCAN ELITE for the following goods and services:

[V]ideo and audio products and systems, namely, televisions, projection televisions, plasma display televisions, video cassette recorders, DVD players, DVD players with built-in DVD recorders, televisions with built-in video cassette recorders, televisions with built-in DVD players, televisions with built-in video cassette recorder and DVD player, audio receivers, audio speakers and home theater systems consisting of any combination of stereo amplifiers, DVD players, video cassette recorders and audio speakers.

This proposed registration of the SUPERSCAN ELITE mark directly conflicts with Pioneer's existing registration for its "Elite" mark.

B. Procedural Background

Pursuant to this Board's order, discovery closed in this matter on May 30, 2004. The depositions, which are the subject matter of this motion, were all set (ANTHONY DUDA on 5/11/02 @ 2:00 p.m.; DENNIS BATTAGLIA on 5/12/04 @ 10:00 a.m.; YUJI HIDAKA on 5/12/04 @ 2:00 p.m., MASATSUGU MISU on 5/13/04 @ 10:00 a.m. and SHIGEHICO KOBAYASHI on 5/13/04 @ 2:00 p.m.) prior to that discovery cut-off date. The deposition notices for all these depositions were mailed on April 19, 2004 and deposition subpoenas were served. On April 21, 2004, Applicant's counsel William McGrath wrote to Mr. Skousen (See Exhibit "G"), unilaterally

¹HHTA originally filed its Application as Nissei Sangyo America, Ltd. It is currently known as Hitachi High Technologies America, Inc.

cancelling the depositions because they "struck him as harassment." On that same day, Mr. McGrath filed a motion for a protective order with the Board, although he had already decided and taken steps to cancel the depositions. The Motion for the Protective Order is still pending and no Board order has been issued. Mr. McGrath continues to refuse to produce these witnesses for deposition despite the absence of a protective order. Accordingly, Pioneer respectfully urges the Trademark Trial and Appeal Board ("the Board") to grant this motion for sanctions dismissing the SUPERSCAN ELITE application, or alternatively, to order that the individual depositions of Deponents be taken in Los Angeles, California at a time and place convenient to Pioneer and HHTA.

1. PIONEER HAS A RIGHT TO DEPOSE ANTHONY DUDA
BECAUSE DOCUMENTS PRODUCED BY HHTA DEMONSTRATE
THAT HE HAS RELEVANT INFORMATION

[THIS SECTION FILED UNDER SEAL PURSUANT TO STIPULATED
PROTECTIVE ORDER DATED JANUARY 31, 2003.]

[THIS SECTION FILED UNDER SEAL PURSUANT TO STIPULATED
PROTECTIVE ORDER DATED JANUARY 31, 2003.]

2. PIONEER HAS A RIGHT TO DEPOSE DENNIS BATTAGLIA
BECAUSE DOCUMENTS PRODUCED BY HHTA DEMONSTRATE HE
HAS RELEVANT INFORMATION

[THIS SECTION FILED UNDER SEAL PURSUANT TO STIPULATED
PROTECTIVE ORDER DATED JANUARY 31, 2003.]

3. PIONEER HAS A RIGHT TO DEPOSE YUJI HIDAKA BECAUSE
DOCUMENTS PRODUCED BY HHTA DEMONSTRATE HIS
KNOWLEDGE OF RELEVANT INFORMATION

[THIS SECTION FILED UNDER SEAL PURSUANT TO STIPULATED
PROTECTIVE ORDER DATED JANUARY 31, 2003.]

[THIS SECTION FILED UNDER SEAL PURSUANT TO STIPULATED
PROTECTIVE ORDER DATED JANUARY 31, 2003.]

4. PIONEER HAS A RIGHT TO DEPOSE MASATSUGU MISU
BECAUSE DOCUMENTS PRODUCED BY HHTA DEMONSTRATE HE
HAS RELEVANT INFORMATION

[THIS SECTION FILED UNDER SEAL PURSUANT TO STIPULATED
PROTECTIVE ORDER DATED JANUARY 31, 2003.]

[THIS SECTION FILED UNDER SEAL PURSUANT TO STIPULATED
PROTECTIVE ORDER DATED JANUARY 31, 2003.]

5. PIONEER SHOULD NOT BE PRECLUDED FROM DEPOSING
SHIGEHICO KOBAYASHI SINCE DOCUMENTS PRODUCED BY
HHTA DEMONSTRATE HIS KNOWLEDGE OF FACTS SUPPORTING
PIONEER'S CLAIMS AND HHTA'S CORPORATE KNOWLEDGE IN
THIS MATTER

[THIS SECTION FILED UNDER SEAL PURSUANT TO STIPULATED
PROTECTIVE ORDER DATED JANUARY 31, 2003.]

[THIS SECTION FILED UNDER SEAL PURSUANT TO STIPULATED
PROTECTIVE ORDER DATED JANUARY 31, 2003.]

III

ARGUMENT

A. APPLICANT'S REFUSAL TO PRODUCE ITS EMPLOYEES AND
OFFICERS FOR DEPOSITION WAS COMPLETELY WITHOUT LEGAL MERIT
AND JUSTIFIES THIS BOARD IN SANCTIONING APPLICANT

It has long been held that absent a court order preventing the taking of depositions, the depositions should go forward. The filing of a motion for a protective order does not stay the deposition. Only a properly issued court order has that effect. This very issue was addressed by the court in the case of *Pioche Mines Consol., Inc. V. Dolman*, 333 F. 2d 257 (9th Cir. 1964). In discussing the effect of

the mere filing of a motion for a protective upon the taking of a scheduled deposition, the court stated:

"Counsel's view seems to be that a party need not appear if a motion under Rule 30 (b), F.R.Civ.P. is on file, even though it has not been acted upon. Any such rule would be an intolerable clog upon the discovery process. Rule 30 (b) places the burden on the proposed deponent to get an order, not just to make a motion. And if there is not time to have his motion heard, the least that he can be expected to do is to get an order postponing the time of the deposition until his motion can be heard. He might also appear and seek to adjourn the deposition until an order can be obtained. (Rule 30 (d)). But unless he has obtained a court order that postpones or dispenses with his duty to appear, that duty remains. Otherwise, as this case shows, a proposed deponent, by merely filing motions under Rule 30 (b), could evade giving his deposition indefinitely. Under the Rules, it is for the court, not the deponent or his counsel, to relieve him of the duty to appear."

Id. at 269.

This rule was made "crystal clear" by the court in *F.A.A. v. Landy* 705 F. 2d 624 (2d Cir. 1983), where the court stated:

"It is clear, however, that **it is not the filing of such a motion** (motion for a protective order) **that stays the deposition, but rather a court order.**"

Id. at 634.

All parties agree that Applicant's counsel, William McGrath, unilaterally cancelled the properly scheduled depositions, which are the subject matter of this motion. At the time of his actions, Mr. McGrath did not have any Board order preventing the taking of those depositions. In fact, as Mr. McGrath points out in his letter of April 21, 2004 (Exhibit "G"), he cancelled the depositions because they "struck him as harassment." At no time, between the time of the filing of the motion for a protective order and the scheduled deposition dates, did Applicant's counsel do anything to get an order for an early hearing of the motion or to postpone or adjourn the depositions pending a hearing on the motion for a protective order. In fact, applicant's motion for a protective order is now moot as he has already taken his unauthorized actions. The Board should simply rule on the instant motion to compel the depositions of applicant's employees.

These facts clearly show that Applicant's counsel, without any legal basis whatsoever, simply cancelled these depositions because of his personal feelings. In no way can these actions be defended. This continuing obstructionist pattern of unauthorized and unjustified conduct should not be condoned. This board should sanction Applicant to deter these meritless tactics and behavior.

B. THE TRADEMARK TRIAL AND APPEAL BOARD IS AUTHORIZED TO
HEAR AND DECIDE MOTIONS FOR SANCTIONS PURSUANT TO 37
C.F.R. § 2.120(g)(2) AND, ALTERNATIVELY, MOTIONS FOR
ORDERS COMPELLING DEPOSITIONS

It is well settled that the Board has authority to compel the attendance of a witness at a discovery deposition. Trademark Rule of Practice 2.120(a) makes the Federal Rules of Civil Procedure, with respect to discovery, applicable to proceedings before the Board unless they are otherwise abrogated by the Trademark Rules:

Wherever appropriate, the provisions of the Federal Rules of Civil Procedure relating to discovery shall apply in opposition, cancellation, interference and concurrent use registration proceedings except as otherwise provided in this section.
37 C.F.R. § 2.120(a).

Consequently, this provision makes Federal Rule of Civil Procedure 37 applicable to TTAB proceedings where a party fails to cooperate in the taking of discovery. Rule 37(d) states, in pertinent part:

(d) Failure of Party to Attend at Own Deposition or Serve Answers to Interrogatories or Respond to Request for Inspection. If a party or an officer, director, or managing agent of a party or a person designated under Rule 30(b)(6) or 31(a) to testify on behalf of a party fails (1) to appear before the officer who is to take the deposition, after being served with a proper notice...the court in which the action is pending on motion may make such orders in regard to the failure as are just, and among others it may take any action authorized under subparagraphs (A), (B), and (C) of subdivision (b)(2) of this rule.

Fed. R. Civ. P. 37(d) (emphasis original).

In *Burnett v. Venturi*, 903 F. Supp. 304 (N.D.N.Y. 1995), the court specifically interpreted Federal Rule of Civil Procedure 37(d) relating to the failure to appear for a deposition, stating:

"Federal Rule of Civil Procedure 37(d) allows the imposition of sanctions against a party for serious disregard of the obligations imposed by the federal discovery rules even though the party has not violated any court order. Failure to appear at a deposition...are examples of the kinds of violations cited"

Id. at 308 (emphasis added).

The *Burnett* court went on to explain the purpose of this rule, stating:

"Disciplinary sanctions under Rule 37 are intended to serve three functions. First, they ensure that a party will not benefit from its own failure to comply. Second, they are specific deterrents and seek to obtain compliance with either court orders or the ordinary standards of care appropriate for parties and their attorneys. Third, they are intended to serve as a general deterrent in the case that the party against whom they are imposed was in some sense at fault".

Id.

Subparagraphs (A), (B), and (C) of Rule 37(b)(2), which are referenced in Rule 37(d) authorize the following sanctions:

(A) An order that the matters regarding which the order was made or any other designated facts shall be taken to be established for the purposes of the action in accordance with the claim of the party obtaining the order;

(B) An order refusing to allow the disobedient party to support or oppose designated claims or defenses, or prohibiting that party from introducing designated matters in evidence;

(C) An order striking out pleadings or parts thereof, or staying further proceedings until the order is obeyed, or dismissing the action or proceeding or any part thereof, or rendering a judgment by default against the disobedient party.

Fed. R. Civ. P. 37(b)(2).

Trademark Rule 2.120(g)(2), the TTAB companion provision to Rule 37(d), states:

If a party, or an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or 31(a) of the Federal Rules of Civil Procedure to testify on behalf of a party, fails to attend the party's or person's discovery deposition, after being served with proper notice, or fails to provide any response to a set of interrogatories or to a set of requests for production of documents and things, and such party or the party's attorney or other authorized representative informs the party seeking discovery that no response will be made thereto, the Board may make any appropriate order, as specified in paragraph (g)(1) of this section.

37 C.F.R. § 2.120(g)(1) (West 2004).

Subsection (g)(2) makes reference to Trademark Rule 2.120(g)(1), which states in relevant part:

If a party fails to comply with an order of the Trademark Trial and Appeal Board relating to discovery, including a protective order, the Board may make any appropriate order, including any of the orders provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure.

37 C.F.R. § 2.120(g)(2) (West 2004).

Applying this statutory authority to the facts at hand, it is obvious that the Board has authority to issue an order compelling these depositions, just as it was required to do previously in this case with the deposition of Applicant employee Mike Levans. The Board also has authority to make an order based on the sanctions authorized for the deterrence of such conduct, pursuant to Federal Rule of Civil Procedure 37, including an order compelling the depositions, striking any claim or defense of Applicant or entering judgment against Applicant. The history of this case shows that Applicant's counsel has previously engaged in the same obstructionist discovery tactics, requiring the filing of a previous motion to compel deposition by Pioneer. In light of this ongoing pattern of obstruction and the court's announced policy of using Federal Rule 37 as a deterrent to such conduct, moving party respectfully requests this Board to issue its order for judgment in favor of Pioneer in this matter. At a bare minimum, this Board should order that these depositions be taken as requested, with an appropriate sanction against Applicant to deter this type of conduct in the future.

C. THE BOARD SHOULD ISSUE AN ORDER DISMISSING HHTA'S APPLICATION

Subsection (g) (1) of Trademark Rule 2.120 and Federal Rule of Civil Procedure 37 authorize the Board to issue an appropriate sanction for the failure and refusal to appear at a deposition. The TBMP clearly provides that sanctions under this section are available where the party failing to

appear has informed the party seeking discovery that no response will be made.

Herein, Mr. McGrath unequivocally stated his position that the Deponents would not be produced for their individual depositions. Specifically, Mr. McGrath stated, in his letters of April 21, 2004 (see Exhibit "G") and May 13, 2004, that he did not intend to produce the Deponents for their duly noticed individual depositions. Mr. Skousen repeatedly provided, as set forth below, legal authority supporting Pioneer's right to take these depositions. Notwithstanding that authority, Mr. McGrath refused and continues to refuse to allow the taking of these depositions. That refusal is patently meritless and justifies the issuance of a severe sanction by this Board to deter these "stonewalling" tactics.

**D. HHTA HAS NOT DEMONSTRATED GOOD CAUSE TO JUSTIFY ITS
ACTIONS IN BLOCKING THE LEGITIMATE DISCOVERY
DEPOSITIONS SOUGHT TO BE TAKEN BY PIONEER**

To obtain a protective order, the Board requires that a moving party demonstrate "good cause":

Upon motion by a party from whom discovery is sought, and for good cause, the Trademark Trial and Appeal Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders provided by clauses (1) through (8), inclusive, of Rule 26(c) of the Federal Rules of Civil Procedure.

37 C.F.R. 2.120(f) (West 2004).

Additionally, the movant must demonstrate that extraordinary circumstances exist. It is well settled that "[a]bsent a **strong** showing of **good cause and extraordinary circumstances**, a court should not prohibit the taking of a deposition." *Motsinger v. Flynt*, 119 F.R.D. 373, 378 (D. N.C. 1988) (emphasis added) (denying plaintiff's motion for protective order barring the taking of his deposition). Even HHTA's cited legal authority concedes that "the party seeking a protective order bears the burden to show good cause." To establish good cause, "the movant must submit 'a particular and specific demonstration of fact, as distinguished from stereotyped and conclusory statements.'" However, a protective order that prohibits the taking of a deposition altogether is rarely granted in the absence of **extraordinary circumstances**." *FMR Corp. v. Alliant Partners*, 51 U.S.P.Q.2d. 1759, 1761 (T.T.A.B. 1999) (emphasis added).

This places the burden squarely on HHTA to show some plainly adequate reason as to why these depositions should not be taken. *F.C.C. v. Schreiber*, 329 F.2d 517, 534 (9th Cir. 1964) (dissenting opinion), modified 1965, 85 S.Ct. 1459, 381 U.S. 279, 14 L.Ed.2d 383 ("Under these authorities, a person seeking a protective order in discovery proceedings has the **burden of justifying it**"). See also *Essex Wire Corp. v. Eastern Elec. Sales Co.*, 48 F.R.D. 308, 310 (D. Pa. 1969).

The existence of good cause for a protective order "is a factual matter to be determined from the nature and character of the information sought by deposition or interrogatory weighed in the balance of the factual issues involved in each action." *Glick v. McKesson & Robbins, Inc.*, 10 F.R.D. 477, 479 (D. Mo. 1950). To meet its burden, HHTA would have to come forward with detailed information supporting its request for a protective order barring the taking of the depositions. Federal law requires such a showing. In fact, courts have held that Defendant's objections to relevant discovery requests were insufficient to warrant issuance of a protective order where defendant alleged in a conclusory manner only that the "request was overly-broad, not specific, and created a hardship on the producing party." *McLeod, Alexander, Powel & Apffel, P.C. v. Quarles*, 894 F.2d 1482, 1484-85 (5th Cir. 1990). In *Panola Land Buyers Ass'n v. Shuman*, 762 F.2d 1550, 1559 (11th Cir. 1985), one party objected to discovery by stating that the discovery requests were "unnecessary, too long, too broad, require too much time, are expensive to complete, are irrelevant, are improperly timed, and entail unreasonable geographic compliance." *Id.*

With regard to those objections, the court held that "[n]o mention of the Rule 26(b) factors is made in sufficient specificity to allow the magistrate and the district court, absent an abuse of discretion, to grant the motion for a protective order. The recitation of expense and burdensomeness are merely conclusory." *Id.*

In their currently pending motion for a protective order, HHTA makes absolutely no showing of good cause or extraordinary circumstances justifying their unilateral decision not to produce their employees and officers for properly noticed depositions. In fact, HHTA fails to provide any evidence beyond conclusory assertions of its attorneys that the deposition of HHTA employees Messrs. Dennis Battaglia, Yuji Hidaka, Masatsugu Misu, Anthony Duda, Kobayashi, and Hakai would result in annoyance, embarrassment, oppression, undue burden, or expense. HHTA argued that because Michael Levans would be deposed by Pioneer, there is no need to depose his subordinate employees, Messrs. Dennis Battaglia, Yuji Hidaka, Masatsugu Misu, Hakai, and Anthony Duda. That conclusion, based on the statements of **Applicant's counsel only**, is that the knowledge of the witnesses is duplicative of that of Mr. Levans. There is absolutely **no evidence** to support that conclusion and it is contradicted by the numerous e-mails attached as exhibits to this motion. HHTA's position is untenable and their claimed basis for it is completely bereft of any factual showing of **good cause or extraordinary circumstances**.

HHTA asserts that the depositions of the subordinate employees will be "expensive" and "disruptive" to the "operations of the Electronics Products Division." These are not valid grounds that support a motion for a protective order or justify non-compliance with a properly served

deposition subpoena. In *FMR Corp. v. Alliant Partners*, upon which HHTA relied in its own motion, the court stated:

"As a general rule a motion for a protective order, that a discovery deposition not be had, is usually denied when the only grounds advanced are that the deponent is too **busy**, or that the examination would cause **undue labor, expense or delay.**"

FMR Corp. v. Alliant Partners, 51 U.S.P.Q.2d, 1759, 1761 (T.T.A.B. 1999) (emphasis added).

Thus, unsupported allegations that a deposition would be "disruptive" or "expensive" do not constitute good cause for granting a motion for a protective order. Nowhere in Applicant's motion is there any competent evidence to show that these depositions would be expensive or disruptive. Furthermore, because HHTA admits that the persons Pioneer seeks to depose are "subordinates," Pioneer's deposition of each witness would not be likely to disrupt the operations of a large company like HHTA.

The Court has long held that a **claim** of "duplicative" discovery does not demonstrate good cause for refusing to respond to discovery either:

"General objections, such as the objection that the interrogatories will require the party to conduct research and compile data, or that they are unreasonably burdensome, oppressive, or vexatious,...or that they would cause annoyance,

expense, and oppression to the objecting party without serving any purpose relevant to the action, or that they are **duplicative of material already discovered through depositions, or that they are irrelevant and immaterial, or that they call for opinions and conclusions, are insufficient.**"

Apco Oil Corp. v. Certified Transp., Inc., 46 F.R.D. 428, 430 (W.D. Mo. 1969).

In the instant matter, Mr. McGrath is refusing to produce the respective deponents for deposition on the very grounds which the Apco court classified as insufficient. In his letter of April 21, 2004 (Attached as Exhibit "G"), Mr. McGrath writes:

"Your request for depositions of five additional persons from HHTA...strikes me as harassment. Given the extensive discovery that has already taken place, and given that Mr. Levans will be available for another day of deposition, those additional depositions are **duplicative and unwarranted**".

It is clear that Mr. McGrath's refusal to allow these depositions to take place, is not supported by law. In fact, the law directly contradicts his position. In light of the repeated pattern of unwarranted and obstructionist objections to discovery, this Board should order an appropriate deterrent sanction (pursuant to Federal Rule of Civil Procedure 37) and dismiss HHTA's application.

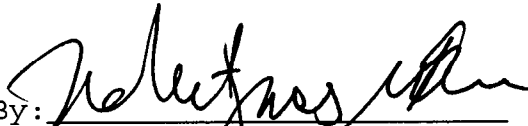
Alternatively, this Board should grant this motion and order that the discovery period be re-opened **solely** for the limited and specific purpose of allowing Pioneer to take the discovery depositions of Messrs. Duda, Battaglia, Hidaka, Misu and Kobayashi.

IV. CONCLUSION

Based on the foregoing facts, arguments, and points of law, Pioneer respectfully, yet earnestly, urges the Board to grant this motion for sanctions and order the dismissal of HHTA's SUPERSCAN ELITE application as an appropriate sanction for their complete and repeated attempts to affirmatively obstruct Pioneer's legitimate discovery efforts. Alternatively, the Board should grant the motion to compel and order HHTA to produce Deponents for their depositions in Los Angeles, California, at a place and time convenient for Pioneer and HHTA.

Dated: July 19, 2004

SKOUSEN & SKOUSEN
A Professional Corporation

By: 

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CERTIFICATE OF COMPLIANCE WITH FRCP 37 & 37 C.F.R. §

2.120(e)

I Robert James Skousen, certify as follows:

A. I am one of the attorneys for Pioneer Kabushiki Kaisha dba Pioneer Corporation, in the above-captioned opposition now pending before the Trademark Trial and Appeal Board as Opposition Number 125,458.

B. I make this certification in support of Pioneer's Motion for an Order Compelling the Attendance of Deponents at their individual depositions.

C. I hereby certify that counsel for the two parties in this opposition proceeding have met and conferred through written correspondence to discuss the substance of Pioneer's motion for an order compelling the attendance of Deponents at their individual depositions pursuant to Federal Rule of Civil Procedure 30(a)(1).

D. Counsel for the HHTA has not agreed to comply with Pioneer's attempt to take the deposition of Deponents as individual deponents.

E. I have complied with Federal Rule of Civil Procedure 37 and Trademark Rule of Practice 2.120(e) and attempted to secure the attendance of Deponents without Board intervention.

F. On April 16, 2004, I sent a letter to William McGrath, counsel for HHTA, indicating my intent to take Deponents' depositions.

G. On April 21, 2004, I received a letter from Mr. McGrath indicating that he did not intend to produce

Deponents for their individual depositions because, he argued, it was harassment, duplicative and unwarranted. On that same day, Mr. McGrath filed a motion for protective order. That motion is currently pending. This Board has never issued any protective order staying the depositions which are the subject matter of this motion.

H. Attached hereto and incorporated herein by reference are true and correct copies of the following documents submitted in support of this motion to compel:

Exhibit "A" [THIS SECTION FILED UNDER SEAL PURSUANT TO STIPULATED PROTECTIVE ORDER DATED JANUARY 31, 2003.;

Exhibit "B" - [THIS SECTION FILED UNDER SEAL PURSUANT TO STIPULATED PROTECTIVE ORDER DATED JANUARY 31, 2003.;

Exhibit "C" [THIS SECTION FILED UNDER SEAL PURSUANT TO STIPULATED PROTECTIVE ORDER DATED JANUARY 31, 2003.;

Exhibit "D" [THIS SECTION FILED UNDER SEAL PURSUANT TO STIPULATED PROTECTIVE ORDER DATED JANUARY 31, 2003.;

Exhibit "E" [THIS SECTION FILED UNDER SEAL PURSUANT TO STIPULATED PROTECTIVE ORDER DATED JANUARY 31, 2003.;

Exhibit "F" - [THIS SECTION FILED UNDER SEAL PURSUANT TO STIPULATED PROTECTIVE ORDER DATED JANUARY 31, 2003.;

Exhibit "G" - Letters from applicant's Attorney, dated April 21, 2004 and May 13, 2004, respectively.

I certify under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed this 19th day of July 2004.


Robert James Skousen

A

THIS SECTION FILED UNDER
SEAL PURSUANT TO STIPULATED
PROTECTIVE ORDER DATED
JANUARY 31, 2003

PIONEER KABUSHIKI KAISHA dba PIONEER CORPORATION,
Opposer,

vs.

NISSEI SANGYO AMERICA, LTD. n/k/a HITACHI HIGH
TECHNOLOGIES AMERICA, INC.
Applicant.

Opposition No. 125,458

EXHIBIT A
offered by Opposer

B

THIS SECTION FILED UNDER
SEAL PURSUANT TO STIPULATED
PROTECTIVE ORDER DATED
JANUARY 31, 2003

PIONEER KABUSHIKI KAISHA dba PIONEER CORPORATION,
Opposer,

vs.

NISSEI SANGYO AMERICA, LTD. n/k/a HITACHI HIGH
TECHNOLOGIES AMERICA, INC.
Applicant.

Opposition No. 125,458

EXHIBIT B
offered by Opposer

C

THIS SECTION FILED UNDER
SEAL PURSUANT TO STIPULATED
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JANUARY 31, 2003

PIONEER KABUSHIKI KAISHA dba PIONEER CORPORATION,
Opposer,

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TECHNOLOGIES AMERICA, INC.
Applicant.

Opposition No. 125,458

EXHIBIT C
offered by Opposer

THIS SECTION FILED UNDER
SEAL PURSUANT TO STIPULATED
PROTECTIVE ORDER DATED
JANUARY 31, 2003

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TECHNOLOGIES AMERICA, INC.
Applicant.

Opposition No. 125,458

EXHIBIT D
offered by Opposer

THIS SECTION FILED UNDER
SEAL PURSUANT TO STIPULATED
PROTECTIVE ORDER DATED
JANUARY 31, 2003

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Opposer,

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TECHNOLOGIES AMERICA, INC.
Applicant.

Opposition No. 125,458

EXHIBIT E
offered by Opposer

F

THIS SECTION FILED UNDER
SEAL PURSUANT TO STIPULATED
PROTECTIVE ORDER DATED
JANUARY 31, 2003

PIONEER KABUSHIKI KAISHA dba PIONEER CORPORATION,
Opposer,

vs.

NISSEI SANGYO AMERICA, LTD. n/k/a HITACHI HIGH
TECHNOLOGIES AMERICA, INC.
Applicant.

Opposition No. 125,458

EXHIBIT F
offered by Opposer

G

DAVIS, MANNIX & McGRATH

ATTORNEYS AT LAW
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(312) 332-3033

WILLIAM T. McGRATH
(312) 332-4748

FAX (312) 332-6376
wmcgrath@dmmlaw.com

May 13, 2004

Via Fax - 310-782-9579
and First Class Mail

Robert James Skousen
Skousen & Skousen, P.C.
12400 Wilshire Boulevard
Suite 900
Los Angeles, CA 90025-1060

Re: **Pioneer Corp. v. Hitachi High Technologies America, Inc.**
Opposition No. 125,458

Dear Mr. Skousen:

In response to your letter of May 3, 2004, and in an effort to resolve our disagreement about Pioneer's desire to take depositions of numerous HHTA employees in addition to Mr. Levans, HHTA is willing to provide one additional deponent, in the person of Mr. Hidaka. If you agree to seek or conduct no additional depositions of HHTA personnel, we will make Mr. Hidaka available in Chicago at a mutually agreeable time and we will withdraw our motion for protective order.

Because English is not Mr. Hidaka's native language, it will be necessary for you to provide, at Pioneer's expense, a court-certified Japanese translator, as well as a check translator, at the deposition.

If the proposal is acceptable to Pioneer, please let me know.

Very truly yours,

DAVIS, MANNIX & McGRATH



William T. McGrath

WTM:ph

DAVIS, MANNIX & McGRATH

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FAX (312) 332-6376
wmcgrath@dmmlaw.com

April 21, 2004

VIA FACSIMILE 310-782-9579
AND FIRST CLASS MAIL

Robert James Skousen
Skousen & Skousen, P.C.
12400 Wilshire Boulevard
Suite 900
Los Angeles, CA 90025-1060

Re: Pioneer Corp. v. Hitachi High Technologies America, Inc.
Opposition No. 125,458

Dear Mr. Skousen:

With respect to your letter dated April 16, 2004 (not received by me until April 19), the only dates Mr. Levans is available in May is the week of the 24th. Your voicemail to me on April 15 did not indicate that you had a conflict with your calendar on the dates we proposed (May 25-27). Rather, your message stated that you were waiting to hear back from your clients. Your letter, however, states that you have a conflict because of previously scheduled obligations. I would expect that you would have mentioned those previous obligations in your voice message to me.

In any event, if you cannot change those obligations, I suggest we try to schedule Messrs. Levans, McManis and Johnston in early June. I understand that discovery closes on May 30, but my client is willing to agree to allow these depositions to occur in June in light of everyone's busy schedule. No extension of the discovery cut-off or testimony periods will be necessary to accomplish these three depositions.

Your request for depositions of five additional persons from HHTA (we have no idea who Mr. Hakai is) strikes me as harassment. Given the extensive discovery that has already

DAVIS, MANNIX & McGRATH

Letter to Robert Skousen

April 21, 2004

Page 2

taken place, and given that Mr. Levans will be available for another day of deposition, these additional depositions are duplicative and unwarranted. Accordingly, we have filed a motion for a protective order, a copy of which will be sent to you under separate cover. We ask that you withdraw your request for these or any other depositions of HHTA personnel (other than Mr. Levans), and we in turn will withdraw our motion for a protective order.

Very truly yours,

DAVIS, MANNIX & McGRATH

A handwritten signature in black ink, appearing to read 'W. McGrath', written over the printed name.

William T. McGrath

WTM:ph

CERTIFICATE OF MAILING BY "EXPRESS MAIL"

"Express Mail" mailing Label Number ER 977746632 US

I hereby certify that the foregoing (1) OPPOSER'S MOTION FOR SANCTIONS PURSUANT TO TRADEMARK RULE OF PRACTICE 2.120(g)(2) AND FEDERAL RULE OF CIVIL PROCEDURE 37, AND ALTERNATIVELY TO COMPEL THE DEPOSITIONS OF ANTHONY DUDA, DENNIS BATTAGLIA, YUJI HIDAKA, MASATSUGU MISU, and SHIGEHICO KOBAYASHI; (2) MEMORANDUM OF POINTS AND AUTHORITIES; and (3) CERTIFICATE OF ROBERT JAMES SKOUSEN is being deposited with the United States Postal Service, "Express Mail Post Office to Addressee" service in an envelope addressed to the Assistant Commissioner for Trademarks, Box TTAB No Fee, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on July 19, 2004.



Marlene Barnes

CERTIFICATE OF SERVICE

I hereby certify that the foregoing (1) OPPOSER'S MOTION FOR SANCTIONS PURSUANT TO TRADEMARK RULE OF PRACTICE 2.120(g)(2) AND FEDERAL RULE OF CIVIL PROCEDURE 37, AND ALTERNATIVELY TO COMPEL THE DEPOSITIONS OF ANTHONY DUDA, DENNIS BATTAGLIA, YUJI HIDAKA, MASATSUGU MISU, and SHIGEHICO KOBAYASHI; (2) MEMORANDUM OF POINTS AND AUTHORITIES; and (3) CERTIFICATE OF ROBERT JAMES SKOUSEN is being deposited with the United States Postal Service, first class postage prepaid, in an envelope addressed to Mr. William T. McGrath, DAVIS, MANNIX & McGRATH, Attorneys at Law, 125 South Wacker Drive, Suite 1700, Chicago, IL 60606-4402 on July 19, 2004.



Marlene Barnes